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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,195	06/13/2001	Kelvin Brian Dickinson	J3544(C)	6049
201	7590	11/07/2003	EXAMINER	
			GOLLAMUDI, SHARMILA S	
		ART UNIT		PAPER NUMBER
		1616		16
DATE MAILED: 11/07/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/880,195	DICKINSON ET AL.
	Examiner Sharmila S. Gollamudi	Art Unit 1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 September 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 6-12 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1, 6-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Receipt of Amendment D received on September 8, 2003 is acknowledged. Claims 1 and 6-12 are pending included in the prosecution of this application. Claim 13 is withdrawn from consideration.

Election/Restrictions

Newly submitted claim 13 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case applicant's original presentation is directed to a hair oil and new claim is a different invention directed to the method of applying hair oil.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 13 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urko in further view of Chubinsky (5,843,005) in further view of XP-002180877.

Urko teaches massage techniques and massage oils. One type of massage oil contains 30 grams vegetable oil and 20 grams liquid paraffin. Urko teaches the use of most vegetable oil such as olive oil. See column 3, lines 53-60.

Although Urko teaches the suitability of most vegetable oils, Urko does not specify other vegetable oils. Further, Urko does not specify the type of mineral oil.

Chubinsky teaches a device for deep tissue massage and ionic therapy. Chubinsky teaches the use of conventional oil, lotions, and massage oils prior to placing the massage device. See column 9 to 10, line 29-2. Suitable lubricants are mineral oil, coconut oil, wheat germ oil, sesame oil, avocado oil, glycerol, and combinations thereof. See column 6, lines 50-56.

XP teaches a massage oil containing 69.5% light mineral oil, 15% finsolv, 4% avocado oil, 8% sesame oil, 3% coconut oil, and 0.5% alpha-tocopheryl acetate.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings Urko, Chubinsky, and XP-0021180877 and utilize the instant oils in Urko. One would be motivated to look to Chubinsky and incorporate coconut or avocado oil since Chubinsky teaches the suitability and conventional use of these oils and combinations thereof in the massage art. Further, one would be motivated to look at XP and utilize light mineral oil since XP clearly demonstrates the state of the art wherein it is known to use light mineral oil in massage compositions.

Response to Arguments

Applicant argues that that the technologies are non-analogous since Urko is directed towards massage oil and instant invention is directed towards hair oil.

Applicant's arguments have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation "hair oil" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In instant case, the preamble is given weight to the extent that the composition has to be in an oil form and topically applicable.

Further, it should be noted that a recitation of the intended use of the claimed invention such as "hair oil" must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art, which has already been taken into consideration. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As set forth in the rejection above, the secondary reference are relied upon for the specific vegetable oil and mineral oil. Urko teaches the general concept of an oil composition containing vegetable oil and mineral oil. Therefore, one would be motivated to add the instant vegetable oil in Urko's composition since clearly the secondary references teach the conventional use of various vegetable oil such as the instant coconut and avocado oil. Further, the use of light mineral oil, which reads on the instant viscosity range, is considered obvious since clearly it is utilized conventionally in the art of endeavor.

Lastly, in response to the argument that XP does not teach at least 20% vegetable oil, the examiner points out that the rejection is made under obviousness; therefore a single reference is not required to disclose all the claim limitations, otherwise it would be said to anticipate the instant invention. As clearly set forth in the rejection, XP is relied upon as a secondary reference and to teach the conventional use of light mineral oil in the composition. The broad aspect of the invention such as the percent weight limit is taught by the primary reference.

Claims 1 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0546235 by itself or in view of Merianos et al (4,155,994).

EP teaches a hair-restorer containing a mixture of castor oil, almond oil, olive oil, and coconut oil in equal proportions. Glycerol or paraffin oil (liquid) may be added. See abstract and page 5. The example teaches 1/6 parts of each ingredient.

EP does not specify if the paraffin oil is light.

Merianos et al teach hair-conditioning agents. Merianos teaches a hair cream composition containing Drakeol #7, a light mineral oil. Note example 8.

It is deemed obvious to one of ordinary skill in the art to utilize light paraffin oil depending on the desired viscosity of the product since it is known in the cosmetic art that light paraffin oil is less viscous than heavy paraffin oil.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to look to the teachings of Merianos et al and incorporate light mineral oil into the hair composition of EP. One would be motivated to do so since Merianos teaches the state of the prior art and the known use of light mineral oil in hair compositions.

In regards to the "consisting essentially of" language, the instant language limits the scope of the claims to components that do not materially affect the basic and novel characteristic of the claimed invention. Therefore, EP does not teach materials that affect the basic characteristic by the inclusion of castor oil since the claims are read in light of the specification that discloses utilizing other oil, i.e. castor oil, without affecting the basic composition.

Response to Arguments

Applicant argues that EP is a hair-restorer intended to stop hair loss and applicant's invention is different in that it conditions hair. Applicant argues that the paraffin oil taught is not light mineral oil and is outside the range of the applicant's range. Applicant argues that the secondary reference is hair cream and not hair oil and contains water. It is further argued that the reference does not state that Drake oil is light mineral oil.

Applicant's arguments have been fully considered but they are not persuasive. First, the examiner points out that the method of use or function does not hold patentable weight in a product claim. Therefore, the argument that E teaches a hair-restorer is moot since the method claim is withdrawn as being drawn to an invention not originally presented.

Second, it is the examiner's position that the weight of the individual oils and the viscosity of the mineral oil are manipulative parameters that are obvious to one of ordinary skill in the art. The applicant's claims 20% and the invention exemplifies 16%. The differences in concentration will not support patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical.

Lastly, it is pointed out that the secondary reference is relied solely upon for its teaching of light mineral oil. Drake oil is defined on column 4, lines 57-60. The examiner points out that the primary reference teaches the broad aspect of the invention and the secondary is relied upon to demonstrate the conventional use of light mineral oil in the

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hair art. Therefore, it is the examiner's position that interchanging paraffin oil for light paraffin is obvious since light mineral oil is used conventionally in the hair art and one would be motivated to use one over the other to yield the desired consistency.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is (703) 305-2147. The examiner can normally be reached on M-F (7:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Sharmila Gollamudi
[Signature]
November 3, 2003.

M. Hartley
MICHAEL G. HARTLEY
PRIMARY EXAMINER